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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,377	05/02/2001	Dennis Mendiola	YSAP.CHIKKA.PT2	3927
24943	7590	01/05/2005	EXAMINER	
INTELLECTUAL PROPERTY LAW GROUP LLP			EWART, JAMES D	
12 SOUTH FIRST STREET			ART UNIT	
SUITE 1205			PAPER NUMBER	
SAN JOSE, CA 95113			2683	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/846,377	<b>Applicant(s)</b> MENDIOLA ET AL.	
	<b>Examiner</b> James D Ewart	<b>Art Unit</b> 2683	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>August 30, 2004</u> . | 6) <input type="checkbox"/> Other: ____  |

***Response to Arguments***

1. Regarding the objection to the drawings, applicants amendments have overcome the objections, therefore the objections to the specification are withdrawn.
2. Regarding the objection to the IDS, applicants submission of new IDS with the amendment have overcome the objections, therefore the objections to the IDS are withdrawn.
3. Regarding the objection to claim 17, applicants amendments have overcome the objections, therefore the objections to the claim is withdrawn.
4. Regarding the 35 USC § 112 rejection to claims 21 and 22, applicants cancellation of these claims have overcome the rejections, therefore the rejections to the claims are withdrawn.
5. Applicant's arguments filed February 05, 2004 have been fully considered by the Examiner, are persuasive. Examiner will provide another reference which teaches "automatically allocating a unique identifier to the prospective user" and "sending notification of said unique identifier to said prospective user at the client specific address of the prospective user".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 11, 21, and 22 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al. (U.S. Patent Publication No 2001/0034224) in view of Dennis (PCT/US98/26785) and further in view of Ilse et al (U.S. Patent No 6,757,898)

Referring to claims 1 and 11, , McDowell et al. teaches a method for assigning a unique identifier to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types (0008), selectively interconnected to an IM server by way of a computer network (Figure 1; 12), the method comprising the following steps: receiving a client specific access address of a prospective user (0029, 0030), allocating a unique identifier to the prospective user (0030); matching said unique identifier to the client specific access address of the prospective user (0030) and storing the matched unique identifier and client specific access address with said IM server under the unique identifier (0030), but does not teach registering or tentatively registering an account over a computer network and confirming the registering of the prospective user associated with a direct request to register from the prospective user. Dennis teaches registering or tentatively registering an account over a computer network and confirming the registering of the prospective user associated with a direct request to

register from the prospective user (Page 10, Lines 3 - 16 and Figure 1). Therefore it would have been obvious to combine the art of McDowell et al. with the teaching of Dennis teaches registering or tentatively registering an account over a computer network and confirming the registering of the prospective user associated with a direct request to register from the prospective user to provide a system and method for users to control the delivery of information to a wireless device and to control services provided to the device (Page 3, Lines 2-4).

McDowell et al and Dennis teach the limitations of claims 1 and 11, but do not teach automatically allocating a unique identifier to the prospective user and sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either confirming the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial receiving was associated with a request to register from someone other than the prospective user. Ilsen et al. teaches automatically allocating a unique identifier to the prospective user (Column 30, Lines 22-25) and sending notification of said unique identifier to said prospective user at the client specific address of the prospective user (Column 30, Lines 25-26), either confirming the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial receiving was associated with a request to register from someone other than the prospective user (Column 30, Lines 22-26). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of McDowell et al and Dennis with the teaching of Ilsen et al. of automatically allocating a unique identifier to the prospective user and sending notification of

said unique identifier to said prospective user at the client specific address of the prospective user, either confirming the registration of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user in cases where unique identifiers of user information are not met (Column 30, Lines 22-26).

Referring to claim 2, McDowell et al. further teaches wherein the unique identifier is a UIN (0030).

Referring to claim 3, Dennis further teaches wherein said computer network is the internet and/or any direct electronic link (Figure 1; 102).

Referring to claim 4, Dennis further teaches wherein the prospective user has an email-based client application for accessing the IM system (Page 10, Line 25).

Referring to claim 5, McDowell et al. further teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014).

Referring to claim 6, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and

manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

7. Claims 7, 9, 10, 12-16, 17, and 19 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al., Dennis and Ilsen et al and further in view of Patil (U.S. Patent No. 6,625,460).

Referring to claims 7, 9, 17 and 19, McDowell et al., Dennis and Ilsen et al teach the limitations of claims 7 and 9 including wherein the prospective user sends client specific address to a web page, but do not teach sending information via e-mail. Patil teaches sending information via e-mail (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al., Dennis and Ilsen et al with the teaching of Patil of sending information via e-mail to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

Referring to claim 10, McDowell et al., Dennis and Ilsen et al teach the limitations of claim 10 including wherein said client specific address is sourced from a web page, but do not teach sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server. Patil teaches sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al., Dennis and Ilsen et al

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with the teaching of Patil of sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

Referring to claim 12, McDowell et al. further teaches wherein the unique identifier is a UIN (0030).

Referring to claim 13, Dennis further teaches wherein said computer network is the internet and/or any direct electronic link (Figure 1; 102).

Referring to claim 14, Dennis further teaches wherein the prospective user has an email-based client application for accessing the IM system (Page 10, Line 25).

Referring to claim 15, McDowell et al. further teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014).

Referring to claim 16, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).



8. Claim 8 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al., Dennis and Ilsen et al and further in view of Smith et al. (U.S. Patent No. 6,333,973).

Referring to claim 8, McDowell et al., Dennis and Ilsen et al teach the limitations of claim 8, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al., Dennis and Ilsen et al with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20).

9. Claims 18 and 20 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al., Dennis, Ilsen et al and Patil and further in view of Smith et al. (U.S. Patent No. 6,333,973).

Referring to claims 18 and 20, McDowell et al., Dennis, Ilsen et al and Patil teach the limitations of claims 18 and 20, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al., Dennis,

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Ilse et al and Patil with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20)

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Germesheid et al. discloses method and apparatus for a web application server to automatically solicit a new password when an existing password has expired.

Grube et al. U.S. Patent No. 6,157,829 discloses method of providing a temporary access of a calling unit to an anonymous unit.

Katz U.S. Patent Publication No. 2001/0021245 discloses telephonic-interface statistical analysis system.

Kavak U.S. Patent No. 6,831,918 discloses IP/ATM network system adapted for the simultaneous transmissions of IP data packets to a plurality of users.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D Ewart whose telephone number is (703) 305-4826. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on (703)308-5318. The fax phone numbers for the organization where this application or proceeding is

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assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

*Ewart*

*December 28, 2004*



WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600